

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
October 4, 2005
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bose Corporation

Serial No. 74734496

Request for Reconsideration

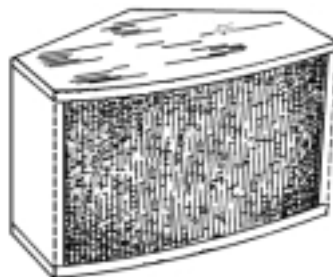
Charles Hieken of Fish & Richardson P.C. for Bose
Corporation.

Glenn G. Clark, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Hairston, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

The Board, in a final decision dated July 12, 2005,
affirmed the refusal to register the following product
design for "loudspeaker systems,"



on the grounds that under the doctrine of *res judicata*,
applicant has already had a full and fair opportunity to

prosecute this proposed mark for identical goods, and that the proposed design still consists of a *de jure* functional configuration of a loudspeaker system.¹

In its request for reconsideration, applicant alleges that this Board: failed to follow critical legal precedents, overlooked the fact that the curved front edges of the speaker enclosure are not functional, and ignored testimony that alternative speaker designs would be less expensive. This opinion presumes familiarity with our final decision, and briefly explains why, contrary to applicant's allegations, we did not overlook relevant law and facts in reaching our earlier decision on this matter, and hence, deny applicant's request for reconsideration.

In finding this design to be a *de jure* functional configuration, we noted the importance of the first factor of the Morton-Norwich test², i.e., the existence of a utility patent that discloses the utilitarian advantages

¹ Application Serial No. 74734496 was filed on September 26, 1995, based upon applicant's allegation of first use and first use in commerce at least as early as September 1976. The application, as amended, contains a statement that the lines and stippling in the drawing are features of the mark and do not indicate color. In the course of prosecution, applicant has described this product design as consisting of "an enclosure and its image of substantially pentagonal cross section with a substantially pentagonal-shaped top with a curved front edge parallel to a substantially pentagonal-shaped bottom with a curved front edge."

² From the oft-cited case of In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

of the design sought to be registered. Applicant's two expired utility patents repeatedly disclose the utilitarian advantages of this particular design. For example, Claim 12 of applicant's Patent No. 3,582,553 claims "[a] loudspeaker system ... wherein said rear baffles are contiguous flat panels forming an angle, and said loudspeaker cabinet comprises a pair of side panels each interconnecting a respective normally vertical edge of said front panel with a normally vertical edge of a respective rear baffle flat panel to define said internal volume as of pentagonal cross section and interconnecting generally parallel top and bottom panels to coact therewith and define said internal volume." [Emphasis added.]

Accordingly, this patent explicitly claims the pentagonal shape of the applied-for design. We found that the pentagonal shape of the loudspeaker enclosure and the precise placement on the back panels of eight full-range drivers, as claimed in applicant's expired patents, have inherent utilitarian value and continue to be the essential features of these speakers.

The United States Supreme Court has reaffirmed that, if the product configuration sought to be registered as a

mark is the subject of a utility patent that discloses the feature's utilitarian advantages, the applicant bears an especially heavy burden of overcoming the strong evidentiary inference of functionality:

A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

TrafFix Devices, Inc. v. Marketing Displays, Inc., 532

U.S. 23, 58 USPQ2d 1001, 1005 (2001). Therefore, we correctly found that applicant's proposed mark is functional.

Applicant objects strenuously to our finding that there is a critical difference in how its configuration evolved as contrasted with the configuration litigated in the case of In Re Honeywell Inc., 8 USPQ2d 1600 (TTAB 1988), a decision that applicant has made the centerpiece of its arguments in the instant case. We stated that:

[t]he Honeywell record shows that the round configuration was chosen for source-indicating purposes, and that then the other components were designed to fit the round configuration. Here, the pentagonal shape is a clear derivative of the angled rear panels that are integral to the utility patents herein.

Slip opinion, p. 12. As this panel discussed in our July decision, applicant's patented technology requires that the drivers be directed at specific angles in a specially shaped enclosure. "It is obvious that if the back of a conventionally shaped speaker cabinet is replaced with two angled panels, this results in a pentagonally shaped enclosure." In re Bose Corporation, 215 USPQ 1124, 1126 (TTAB 1982).

Applicant does not deny that the patented technology requires a functional configuration, namely that the drivers be placed into two panels connected at a precise angle (e.g., 120°) in a specially-shaped enclosure.

Moreover, the explicit claims of applicant's expired patents provide strong evidence of the functionality of the configuration design in the present case when one focuses on whether this is a comparatively simple or inexpensive method of manufacture:

The present invention relates in general to loudspeaker systems and more particularly concerns a novel compact loudspeaker system

that is compact and relatively easy and inexpensive to manufacture and provides realistic reproduction of sound with negligible distortion. [Emphasis supplied.]

Applicant's '553 utility patent, *LOUDSPEAKER SYSTEM*, column 1. As was the case in the TrafFix decision, statements made in Bose's patent applications demonstrate the functionality of the design, and Bose does not assert in later testimony that any of these representations are mistaken³ or inaccurate. See TrafFix at 1006.

Applicant, in its request for reconsideration, continues to make much of the Morton-Norwich factor tied to the availability to competitors of feasible alternative designs - i.e., whether the design is superior to other

³ The testimony of Dr. Bose [Bose Corp. v. Consumers Union, February 26, 1980 (D.C. Mass)], in the context of confusion over what forms of intellectual property were implicated by this design configuration, equivocates ("yes," "no ... some consequences") but certainly does not repudiate the claims made in the patents as to the functional nature of the pentagonally-shaped speaker enclosure:

The Court: Tell me, does [the speaker shape] have any acoustical significance?

The witness: Yes, it does. The shape itself, your Honor?

The Court: Yes, the pentagonal shape itself, does it have an acoustical significance?

The witness: No, the pentagonal shape itself does not. There are some consequences of it, but I don't know how to answer that.

designs, such as a rectangular or triangular design for the speaker enclosure.

The pentagonal shape of this enclosure and the precise placement on the back panels of eight full-range drivers are the reasons applicant claims the device works as it does, so detailed speculation about other designs need not be undertaken, according to the Supreme Court in the TraFFix decision:

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. 200 F.3d, at 940. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

Because the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say by using a box or framework to cover them, as suggested by the Court of Appeals. *Ibid.* The dual-spring design assures the user the device will work. If buyers are assured the product serves its purpose by seeing the operative mechanism, that in itself serves an important market need. It would be at cross-purposes to those objectives, and something of a paradox, were we to require the manufacturer to conceal the very item the user seeks.

TraFFix at 1007.

As noted in this panel's July decision, the Supreme Court in TrafFix reaffirms the traditional rule of Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 214 USPQ 1 (1982), that "a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." 532 U.S. at 32, 58 USPQ2d at 1006.

Regarding the third Morton-Norwich factor, the Federal Circuit has explained that "the [Supreme Court in TrafFix] merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available." Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002). Consistent with this analysis, the Board earlier explicitly took the position that the availability of certain other shapes for speaker enclosures did not detract from the functional character of the involved configuration. In re Bose Corporation, 215 USPQ at 1127.

It is certainly not determinative of the result herein whether or not it is easier or less expensive, for

example, to manufacture the pentagonally-shaped speaker enclosure claimed in Bose's patent, as applicant has for decades, or to design a hypothetical Bose 901 speaker having conventional rectangular top and bottom panels, and then wrapping grill cloth completely around the back portion of the speaker - in a manner that hides the V-shaped portion within a rectangular enclosure.

In this context, we reiterate that we clearly did not overlook the law on functionality as recently set out by the Supreme Court in TrafFix, and we did not overlook any evidence in the current record. Rather, we explicitly considered the testimony before a Federal District Judge given by Dr. Bose and Mr. Greenblatt. We accept the fact that although applicant has not chosen to do so, it could have hidden its patented technology inside a differently shaped enclosure.

Q: What other shapes could it be?

A: It could be triangular cross-section, increased height. That is one way. It could have more panels, more different facets, more than pentagonal.

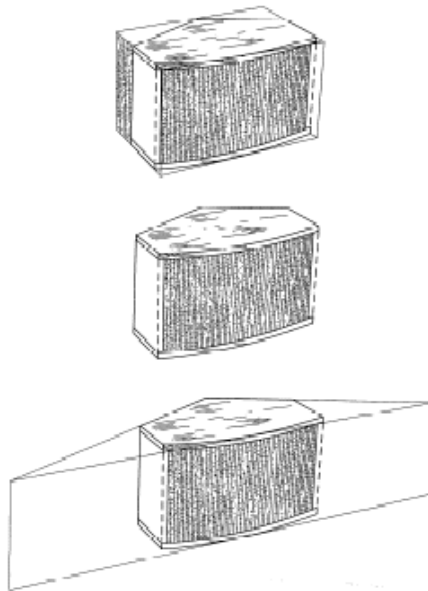
Q: Did Bose consider making it other than a pentagonal shape?

A: Yes; we considered making it rectangular, to look like conventional speakers.

Q: How would you have done this?

A: We would have made the top and bottom plates rectangular and wrapped grill cloth completely around the system enclosing the V-shaped portion inside.

We also considered applicant's drawings showing hypothetical designs of a rectangular shape and a triangular shape drawn around the current speaker enclosure configuration:



However, judging by any measure of aesthetics, marketability, increased manufacturing costs of the additional materials, much heavier speakers or incredible inefficiencies in shipping, this awkward triangular structure must be deemed "unfeasible, uneconomical or otherwise disadvantageous." In re Bose Corporation, 215 USPQ at 1127.

In finding that Bose's appeal was barred by claim preclusion, we stated:

The applicant herein is identical to the applicant in the earlier proceeding, the Court of Appeals for the Federal Circuit rendered a final decision in that action on the issue of *de jure* functionality of the same product configuration as is before us in this proceeding, and no conditions, facts or circumstances of consequence to the issue of *de jure* functionality have changed since that earlier, adverse decision. Hence, we affirm the refusal of the Trademark Examining Attorney to register this matter based upon the doctrine of *res judicata*.

Slip opinion, p. 16.

In its request for reconsideration, applicant argues that we "overlooked key reasons" for rejecting the doctrine of *res judicata* contained in Board precedent.⁴

Specifically, applicant continues to argue, as it did in its main brief on appeal, that the circumstances have changed since Bose's earlier, adverse decisions. Applicant continues to emphasize the "curved front edge" of the speaker enclosure. However, we found that this

⁴ See *In Re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988). In addition to distinguishing this case on its facts, we pointed out that the Seventh Circuit's affirmance in *Eco Manufacturing LLC v. Honeywell International Inc.*, 357 F.3d 649, 69 USPQ2d 1296 (7th Cir. 2003), aff'g 295 F.Supp.2d 854 (S.D. Ind. 2003), seriously undercuts the rationale of the Board's 1988 *Honeywell* decision that applicant has made the centerpiece of its argument in the instant case against our finding *res judicata* as to the issue of *de jure* functionality.

does not represent a change from the applied-for matter in the earlier-filed application. While clearly present in the drawing involved in the earlier litigation, applicant never argued that this was a notable feature of its claimed mark.⁵ Bose's images shown on the drawings in these respective applications are substantially identical.

As to an additional twenty years of usage of this product design since the adverse decisions, while this period of usage may provide support for applicant's claims of acquired distinctiveness, any positive change in the levels of *de facto* recognition by consumers of the design of this speaker enclosure has no impact upon the conclusion that the design is *de jure* functional. We noted that applicant clearly "has not made the argument that the relevant laws of physics have changed over the past twenty years." A design feature that is shown by way of an exhaustive analysis of a utility patent to be *de jure* functional does not become not *de jure* functional by the passage of time, more promotional efforts or increased

⁵ Moreover, Bose's "curved front edge" is not analogous to the hypothetical "case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs [of sign stands]...." *TrafFix* at 1007. The Court's discussion to which applicant analogized is to a manufacturer seeking separate trademark protection for a discrete trade dress flourish that may be shown on a patent drawing, for example.

sales. This too is consistent with the Supreme Court's holding in the TrafFix decision:

Functionality having been established, whether MDI's dual-spring design has acquired secondary meaning need not be considered.

Id. at 1007.

Therefore, we correctly found that Bose's appeal was barred by claim preclusion.

Decision: The final decision dated July 12, 2005, in which we affirmed the refusals to register the configuration of a loudspeaker system based on the grounds that the proposed design is *de jure* functional and under the doctrine of *res judicata*, stands. Applicant's request for reconsideration is hereby denied.